



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,876	10/26/2001	Mark Duchow	670715-90029	1765

7590 01/15/2003

HOWREY SIMON ARONLD & WHITE , LLP
BOX NO.34
750 BERING DRIVE
HOUSTON,, TX 77057-2198

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/682,876

Applicant(s)

Duchow

Examiner
James W. Myhre

Art Unit
3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 17, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, 14-21, and 24-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12, 14-21, and 24-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11 6) ☐ Other:

Art Unit: 3622

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 17, 2002 have been fully considered but they are not persuasive. No claims were amended. However, the previous rejection has been repeated in paragraph 2 below for the Applicant's convenience.

a. The Applicant argues in reference to the 35 U.S.C. 102 rejection of Claims 2, 3, 14, 15, 32, 44, and 53 and in reference to the 35 U.S.C. 103 rejection of Claims 4, 12, 16, 21, 24, and 47 that neither Scroggie (6,185,541) nor Cupps (5,991,739) disclose a "method that automatically selects a retailer based on both product selection and buyer information" (page 3) or based on "buyer selection and buyer location" (page 6). The Applicant also argues that neither reference discloses that a reseller has "a predetermined distribution territory covering the geographic location of the buyer" (page 8). The Examiner notes that as cited by the Applicant (page 6) Scroggie discloses that the shopper "will have to make a selection from a list of supermarkets in the immediate shopping area" (col 9, line 66 - col 10, line 1). This explicitly discloses that the system has already selected one or more retailers within the appropriate geographic location of the shopper (buyer information) and also discloses, since only supermarkets were selected, that the retailer(s) was selected based on the product (or type of product). By selecting supermarket(s) "in the immediate shopping area" of the shopper, Scroggie also discloses that the reseller has a predetermined distribution territory covering the geographic location of the buyer.

Art Unit: 3622

It is inherent that every reseller in the world has a predetermined distribution territory, whether that territory covers one city block, one town, a state, a country, or the whole world. A good example of this are delivery services such as pizza delivery businesses, which will deliver your order free, but only within a certain distance from their place of business.

b. The Applicant also argues that the invention is non-obvious based on commercial success, industry adoption, licensing and copying of the claimed invention. The Examiner notes, however, that the only two features in the dependent claims which were rejected under 35 U.S.C. 103 for obviousness in view of Cupps were the features of letting the buyer enter a preferred producer (manufacturer)(Claims 4, 12, 16, 21, 24, and 47) and for transmitting the information to the buyer using a telephone or fax machine (Claims 34 and 36). None of the affidavits make any mention of either of these features, let alone claim that either of these features contributed to the commercial results discussed. In fact, all of the affidavits point to the features of providing a purchase incentive over the Internet to a user, and of making the incentive redeemable only at a local retail site (local to the user) as the reason for the commercial results. As discussed above, these features were disclosed by Scroggie and have been rejected under 35 U.S.C. 102.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3622

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 2, 3, 5/2, 5/3, 6/2, 6/3, 7/2, 7/3, 8/2, 8/3, 9/2, 9/3, 10/2, 10/3, 11/10/2, 11/10/3, 14, 15, 17/14, 17/15, 18/14, 18/15, 19/14, 19/15, 20/14, 20/15, 25/14, 25/15, 26/14, 26/15, 29/14, 29/15, 32, 33, 35, 37-46, and 53-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Scroggie et al (6,185,541).

Claims 2, 3, 14, 15, 44, 45, 53, and 54: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network, comprising:

- a. Accessing a product database (col 2, lines 11-19 and col 6, lines 12-15);
- b. Displaying a list of products to the buyer (col 2, lines 11-19 and col 6, lines 12-15);
- c. Receiving a product selection from the buyer (col 2, lines 11-19 and col 6, lines 12-15);
- d. Receiving and storing information about the buyer (col 1, lines 53-55 and col 6, lines 32-35 and 55-58);
- e. Accessing a reseller (retail store) database to select a reseller based on the product selection and the buyer information (col 9, line 66 - col 10, line 3); and

Art Unit: 3622

f. Transmitting the reseller information and a discount to the buyer (col 2, lines 1-4), wherein the discount is selected from a discount database based on the selected product (col 9, lines 20-25).

Claims 5/2, 5/3, 25/14, 25/15: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, and 15 above, and further discloses that the computer network is the Internet (col 1, line 31-40).

Claims 6/2, 6/3/ 26/14, and 26/15: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, and 15 above, and further discloses that the discount is a cash discount with an expiration date (col 10, lines 32-49).

Claims 7/2, 7/3, 8/2, 8/3, 17/14, 17/15, 19/14, and 19/15: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, and 15 above, and further discloses that the reseller and discount information is transmitted to the buyer via email (col 12, lines 44-53 and col 13, lines 21-34) or displayed on a website (col 11, lines 48-51 and col 12, lines 44-53).

Claims 9/2, 9/3, 10/2, 10/3, 11/10/2, 11/10/3, 18/14, 18/15, 29/14, and 29/15: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, and 15 above, and further discloses selecting the reseller geographically closest to the buyer, based on the buyer's zip code and email address provided as buyer information (col 6, lines 32-35 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3).

Art Unit: 3622

Claims 20/14 and 20/15: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claims 14 and 15 above, and further discloses sending the buyer information and the discount to the reseller (col 2, lines 63-67).

Claim 32: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network, comprising:

- a. Advertising a plurality of discounts available for a plurality of products (col 13, lines 47-47);
- b. Receiving a product selection and buyer information from a buyer (col 1, lines 53-55; col 2, lines 11-19; and col 6, lines 12-15, 32-35, and 55-58);
- c. Selecting a reseller and discount based on the selected product and buyer information (col 9, line 66 - col 10, line 3); and
- d. Transmitting the reseller and discount information to the buyer (col 2, lines 1-4).

Claim 33: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, and further discloses the incentive is a cash discount with an expiration date (col 10, lines 32-49).

Claim 35: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, and further discloses transmitting the reseller and discount information to the buyer using the postal system (col 10, line 17).

Art Unit: 3622

Claim 37: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, and further discloses selecting the reseller that is geographically closest to the buyer, based on the buyer's zip code and email address provided as buyer information (col 6, lines 32-35 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3).

Claims 38 and 39: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network, comprising:

- a. Receiving buyer information (col 1, lines 53-55 and col 6, lines 32-35 and 55-58);
- b. Determining the reseller covering the geographic area of the buyer (col 6, lines 32-55 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3); and
- c. Transmitting the purchase incentive to the buyer, the purchase incentive being redeemable only at the selected reseller (col 1, lines 47-49; col 2, lines 1-4; and col 10, lines 26-27).

Claim 40: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 38 above, and further discloses printing and redeeming the incentive (electronic voucher) at the reseller (col 1, line 62 - col 2, line 1 and col 12, lines 51-53).

Claim 41: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 40 above, and further discloses the incentive is a cash discount with an expiration date (col 10, lines 32-49).

Art Unit: 3622

Claim 42: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 38 above, and further discloses the buyer information including a zip code and email address (col 6, lines 32-35 and 55-58).

Claim 43: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 38 above, and further discloses that the discount information is transmitted to the buyer via email (col 12, lines 44-53 and col 13, lines 21-34).

Claims 46 and 55: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network as in Claim 44 and 53 above, and further discloses receiving a producer (manufacturer) selection from the buyer and selecting the discount based on the selected producer (col 2, lines 45-51).

Claim Rejections - 35 USC § 103

4. Claims 4, 5/4, 6/4, 7/4, 8/4, 9/4, 10/4, 11/10/4, 12, 16, 17/16, 18/16, 19/16, 20/16, 21, 24, 25/16, 25/24, 26/16, 26/24, 27, 28, 29/16, 29/24, 30, 31, 34, 36, 47-49, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (6,185,541) in view of Cupps et al (5,991,739).

Claims 4, 12, 16, 21, 24, and 47: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, and 15 above, but does explicitly disclose accessing a producer (manufacturer) database, displaying a list of producers to the buyer, and receiving the buyer's selection of a producer prior to accessing and

Art Unit: 3622

displaying the list of products. However, Cupps discloses a similar system and method for providing a purchase incentive to a buyer over a computer network in which a manufacturer database is accessed, a list of manufacturers is displayed to the buyer, and the buyer selects a manufacturer (col 9, line 66 - col 10, line 21) prior to accessing and displaying the products available from that merchant. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allowing buyer to select a manufacturer prior to selecting a product. One would have been motivated to allow the buyer to select the manufacturer in order to better meets the desires of the buyer, especially when “name-brand” items are desired (such as in clothing, watches, automobiles, etc.).

Claims 5/4, 25/16, and 25/24: Scroggie and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 4, 16, and 24 above. Each reference further discloses that the computer network is the Internet (Scroggie, col 1, line 31-40)(Cupps, col 9, lines 37-39).

Claims 6/4, 26/16, and 26/24: Scroggie and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 4, 16, and 24 above. Scroggie further discloses that the discount is a cash discount with an expiration date (col 10, lines 32-49).

Claims 7/4, 8/4, 17/16, 19/16, 27, 28, and 52: Scroggie and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 4, 16, 24, and 47 above. Scroggie also discloses that the reseller and discount information is transmitted

Art Unit: 3622

to the buyer via email (col 12, lines 44-53 and col 13, lines 21-34) or displayed on a website (col 11, lines 48-51 and col 12, lines 44-53).

Claims 9/4, 10/4, 11/10/4, 18/16, 29/16, 29/24, and 51: Scroggie and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2-4, 14-16, 24, and 47 above. Both references further disclose selecting the reseller geographically closest to the buyer, based on the buyer's zip code and email address provided as buyer information (Scroggie, col 6, lines 32-35 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3)(Cupps, col 9, line 66 - col 10, line 21 and Figure 3B, items 150 and 152).

Claim 20/16: Scroggie and Cupps disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 16 above. Scroggie further discloses sending the buyer information and the discount to the reseller (col 2, lines 63-67).

Claims 30 and 49: Scroggie and Cupps disclose a method for providing a purchase incentive to a buyer over a computer network as in Claims 24 and 47 above. Scroggie further discloses printing and redeeming the incentive (electronic voucher) at the reseller (col 1, line 62 - col 2, line 1 and col 12, lines 51-53).

Claim 31: Scroggie and Cupps disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 24 above. Scroggie further discloses presenting the buyer information to the reseller and receiving the discount (col 3, lines 1-6),

Claims 34 and 36: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, but does not explicitly disclose transmitting

Art Unit: 3622

the reseller and discount information to the buyer via a telephone or fax machine. However, Cupps discloses a similar method for providing a purchase incentive to a buyer over a computer network, and further discloses that the information could be transmitted to the buyer over the telephone or a fax machine (col 11, lines 24-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit the information to the buyer in Scroggie using a telephone or fax machine. One would have been motivated to use one of these devices in order to use a more secure means of communicating the information.

Claim 48: Scroggie and Cupps disclose a system for providing a purchase incentive to a buyer over a computer network as in Claim 47 above. Scroggie further discloses the incentive is redeemable only at the selected reseller (col 1, lines 47-49 and col 10, lines 26-27).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 3622

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

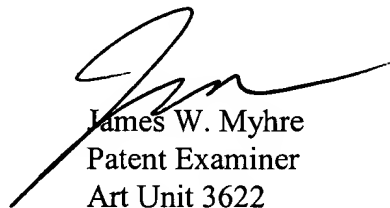
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM

January 9, 2003


James W. Myhre
Patent Examiner
Art Unit 3622